

**REMARKS**

This Response to the Office Action mailed August 31, 2009 is believed to address all issues raised in the Action. Favorable reconsideration of the application is respectfully requested in view of Applicants' remarks herein.

**Formal Matters**

Applicants thank the Examiner for considering the Information Disclosure Statement filed on June 17, 2009, and returning an initialed copy of the PTO/SB/08 form.

**Statement of Substance of Interview**

Applicants thank the Examiner for the telephonic interview conducted on November 5, 2009. As a statement of the substance of the interview, Applicants submit the following:

An Examiner's Interview Summary Record (PTO-413) was attached with the Office Communication dated November 12, 2009.

During the interview, the following was discussed:

1. Brief description of exhibits or demonstration: None
2. Identification of claims discussed: All pending claims
3. Identification of art discussed: Castberg (R1)
4. Identification of principal proposed amendments: See below
5. Brief Identification of principal arguments: See below
6. Indication of other pertinent matters discussed: None
7. Results of Interview: See below
  - a. Castberg Reference (R1)

With regard to the Castberg reference (R1), Applicants explained that, according to the disclosure of R1, CO<sub>2</sub> appears to be an essential element of its fermentation process, and therefore, one of ordinary skill in the art would not have been motivated to modify R1 by removing and replacing CO<sub>2</sub> with nitrogen, as the Examiner asserts. b. Declaration Evidence

Regarding the Examiner's continued assertion that the experimental data provided by Mr. Horiuchi will not be considered unexpected regarding the combination of R1 and R2, Applicants pointed out that this would be "requiring a comparison of the results of the invention with the results of the invention," which is prohibited by the MPEP. The Examiner agreed to re-evaluate his position regarding the comparative evidence provided by Mr. Horiuchi.

c. Optional Claim Amendments

The Examiner suggested that claim 5 could be amended to more clearly set forth the present invention. Specifically, the Examiner suggested replacing the recitation of "an inert gas" with "nitrogen, argon, or helium gas". Further, the Examiner recommended more clearly defining the term "mix of raw materials" so as to clarify the step of "reducing concentration of dissolved oxygen in the mix of raw materials" recited in the claimed fermentation process.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

**It is believed that no petition or fee is required.** However, if the USPTO deems otherwise, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

**Claim Status**

Upon entry of the Amendment, which is respectfully requested, claims 5, 6, 8-12, 14, and 15 will be pending in the application. Claim 5 has been amended to more clearly set forth the subject matter of the present invention by reciting that an inert gas is selected from the group of nitrogen, argon, or helium gas. Support for this amendment of claim 5 can be found in the specification, e.g., page 9, lines 24-26. In addition, claim 5 has been further amended to more clearly recite the subject matter of the present invention by replacing the recitation of "mix of raw materials" with "mixture comprising milk." Support for this amendment of claim 5 can be found in the specification, e.g., page 8, lines 13-17. Claims 14 and 15 are newly added. Support for claim 14 can be found in the specification, e.g., page 9, line 26. Support for claim 15 can be found in the specification, e.g., page 13, Test Example 1. No new matter is added.

**Response to Claim Rejections under 35 U.S.C. § 103(a)**

On page 2 of the Action, claims 5-6 and 8-12 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Castberg et al. (US 5,453,286 [[5,453,256]]; hereinafter R1) in view of Kamiya (EP 1 082 907; hereinafter R2).

Applicants respectfully traverse. R1 and R2 do not anticipate or render obvious the present invention in view of amended claim 5.

Applicants reiterate the arguments of record and assert that there is simply no motivation to combine the cited references and modify the combined teachings to arrive at the present invention. Amended claim 5 recites a method for producing fermented milk, which comprises reducing the concentration of dissolved oxygen in a mixture comprising milk at the start of

fermentation to 5 ppm or less by substituting the dissolved oxygen with an inert gas selected from the group of nitrogen, argon, or helium gas.

In contrast with the present invention, R1 teaches that the introduction of the carbon dioxide in the milk and its continued presence therein improves the milk as a medium for the yogurt starter and the presence of CO<sub>2</sub> can shorten fermentation. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (See MPEP 2143.01 (V)). Therefore, in view of the teachings of R1, it is clear that one of ordinary skill in the art would not have been motivated to modify R1 by removing and replacing CO<sub>2</sub> with an inert gas such as nitrogen, argon, or helium.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious. (See MPEP 2143.01 (III)). In this regard, the Examiner has failed to articulate why the superior results of the present invention would have been predictable to one of ordinary skill in the art in view of the teachings of R1 and R2. In R1, bacteria is merely increased by an anaerobic incubation using a culture and carbonation is conducted after pasteurization of milk, not raw milk as taught by the present invention. On the other hand, in R2, the reduction of dissolved oxygen concentration is carried out before pasteurization of raw milk for the purpose of improving flavor. In the present invention, the reduction of dissolved oxygen concentration, by substituting with an inert gas such as nitrogen, argon, or helium is conducted at the time when the fermentation is started, as recited in claim 1, for the purpose of improving physical properties (texture). Therefore, because the intended purposes and timings of the carbonation in R1 and the reduction of dissolved oxygen and concentration in R2, respectively,

are different, there is no motivation to combine these references to arrive at the present invention with any reasonable expectation of success.

Moreover, Applicants respectfully request the Examiner to reconsider the results shown in the previously submitted Declaration by Mr. Hiroshi Horiuchi, as agreed upon by the Examiner during the telephone interview of November 5, 2009. In this regard, Applicants “cannot be required to compare the claimed invention with an invention suggested by a combination of references.” (In re Chapman, 357 F.2d 418, 148 USPQ 711 (CCPA 1966)). Thus, the Declaration evidence submitted provides the unexpectedly superior results of the method for producing fermented milk and fermented milk produced by the method of the instant invention and establishes why the present invention is distinguished from the teachings of the cited references.

On page 5 of the Action, claims 5-6 and 8-12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Castberg (R1) in view of WO-02248470 (hereinafter R3).

The Examiner concedes that R1 is silent as to the dissolved oxygen concentration and how it can be monitored using an inert gas, but the Examiner relies on R3 to teach this feature of the present invention.

Applicants respectfully traverse. R1 and R3 do not anticipate or render obvious the present invention in view of amended claim 5.

R3, like R1, is silent as to a dissolved oxygen concentration as recited in instant claim 5. Thus, this rejection lacks merit and Applicants traverse on the grounds that the cited references, fail to teach or render obvious each and every feature of the claimed invention. Specifically, the

Examiner has failed to point out where in the cited references there exists a teaching or suggestion to reduce the dissolved oxygen concentration to 5 ppm or less and why one of ordinary skill in the art would have known that such oxygen concentration is effective in shortening the fermentation time.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103 rejections of claims 5-6 and 8-12.

**Claims 14-15**

Claims 14 and 15 should be patentable, at least for the same reasons of patentability of their independent claim 1. With regard to new claim 15, Applicants further submit the following arguments. The object of R2 is to improve the taste of milk by sterilizing milk after substituting the dissolved oxygen in milk with nitrogen, and therefore it is clearly understood by one skilled in the art that substituting the dissolved oxygen in milk with nitrogen before sterilization of milk is mandatory in the process of R2. Therefore, there is simply no teaching or suggestion in R2 about reducing dissolved oxygen after the sterilization of milk as recited in instant claim 15. Therefore, even in view of R2, one of ordinary skill in the art would not combine R2 with R1, in which carbonation is conducted after the sterilization.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 10/537,493

Attorney Docket No.: Q88366

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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**65565**

CUSTOMER NUMBER

Date: November 30, 2009

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